



UNITED STATES PATENT AND TRADEMARK OFFICE

mv

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,617	01/16/2001	Gene A. Bornzin	A01P1002	7875

7590

12/22/2003

Lisa P. Weinberg
Patent Agent
Pacesetter, Inc.
15900 Valley View Court
Sylmar, CA 91392-9221

EXAMINER

OROPEZA, FRANCES P

ART UNIT	PAPER NUMBER
----------	--------------

3762

13

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,617

Applicant(s)

BORNZIN ET AL.

Examiner

Frances P. Oropeza

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/14/03 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-19, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant amended independent claims 1, 15, 16 and 22 to include the limitation that the markers are alphanumeric markers. The Examiner is unable to find support for this limitation in the specification. Based on the specification at page 18, lines 6-7, the marker can be a word or a letter, but the Examiner is unable to find a disclosure that the marker can be a number. New matter may not be entered into the specification at this point in the prosecution. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. Claims 1-9, 13-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. (US 5833623) in view of Adams et al. (US 5304209).

Mann et al. disclose a system for facilitating rapid retrieval of atrial and ventricular capture test data, providing a visual representation of the presence and absence of captured cardiac events (figure 1; col. 3 @ 7-14; col. 7 @ 50-52 & 58-66; col. 9 @ 20-24;

col. 8 @ 12-24 & 31-36; col. 8 @ 65 – col. 9 @ 2; col. 10 @ 60-63; col. 13 @ 62 – col. 14 @ 9;
Table 1 – Vent Capture, Atrial Capture, Loss of Capture).

As discussed in the previous paragraph of this action, Mann et al. disclose the claimed invention except for markers being alphanumeric markers.

Adams et al. teach visual marking for a display means using alphanumeric markers for the purpose of indicating the nature of cardiac activity. It would have been obvious to one having ordinary skill in the art at the time of the invention to have used alphanumeric markers in the Mann et al. system in order to enable the cardiac activity to be visually labeled with an alphanumeric code so the status of the cardiac activity is readily evident to the viewer (col. 7 @ 5-19).

Claim Rejections - 35 USC § 103

3. Claims 10-12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al. (US 5833623) in view of Adams et al. (US 5304209) and further in view of Stroebel (US 5861012). As discussed in paragraph 2 of this action, modified Mann et al. disclose the claimed invention except for selectively activating a means to automatically assess a pacing threshold value, add a safety margin, recommend the pacing amplitude and pulse width, and display the recommended pacing amplitude and pulse width for practitioner review.

Stroebel teaches stimulation threshold measurements using selective activation of a means to automatically assess a pacing threshold value, add a safety margin, recommend the pacing amplitude and pulse width, and display the recommended pacing amplitude and pulse width for practitioner review for the purpose of periodically updating the pacing parameters and providing the practitioner with feedback on the cardiac performance. It would have been

obvious to one having ordinary skill in the art at the time of the invention to have used using selective activation of a means to automatically assess a pacing threshold value, add a safety margin, recommend the pacing amplitude and pulse width, and display the recommended pacing amplitude and pulse width for practitioner review in the modified Mann et al. system in order more frequently define the pacing parameters to minimize the energy usage, hence optimizing battery performance and to provide the practitioner with comprehensive data to optimize the cardiac therapy (col. 3 @ 42-49; col. 4 @ 25-32; col. 5 @ 38-45; col. 8 @ 51-60; col. 11 @ 56-66; col. 19 @ 65 – col. 20 @ 7; col. 27 @ 16-19).

Specification

4. The amendment filed 10/14/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The Applicant amended independent claims 1, 15, 16 and 22 to include the limitation that the markers are alphanumeric markers. The Examiner is unable to find support for this limitation in the specification. Based on the specification at page 18, lines 6-7, the marker can be a word or a letter, but the Examiner is unable to find a disclosure that the marker can be a number.

Applicant is required to cancel the new matter in the reply to this Office Action.

Statutory Basis

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Fran Oropeza, telephone number is (703) 605-4355. The Examiner can normally be reached on Monday – Thursday from 6 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Angela D. Sykes can be reached on (703) 308-5181. The fax phone number for the

Application/Control Number: 09/764,617

Page 6

Art Unit: 3762

organization where this application or proceeding is assigned is (703) 306-4520 for regular communication and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist, telephone number is (703) 308-0858.

Frances P. Oropeza
Patent Examiner
Art Unit 3762

380
11/21/03



ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700